

REMARKS

The present remarks are in response to the Office Action of August 29, 2006. Claims 1-8 are currently pending. Reconsideration of the application is respectfully requested in view of the following responsive remarks. The following matters were addressed by the Examiner:

- (1) Claims 1, 2, and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,429,860 (hereinafter "Held") in view of U.S. Patent No. 6,951,672 (hereinafter "Vincent"); and
- (2) Claims 3-7 were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicants express appreciation for the allowance of claims 3-7.

Rejections under 35 U.S.C. 103(a)

The Examiner has rejected claims 1, 2, and 8 under 35 U.S.C. 103(a) as being unpatentable over Held in view of Vincent. Vincent was published on February 5, 2004, after the filing date of the present invention, October 16, 2003. Therefore, Vincent is a 102(e) reference being used in a 103(a) rejection. However, Vincent has common ownership with the present invention. Both inventions are owned by the Hewlett Packard Company. Hewlett Packard was assigned the interest in Vincent on July 30, 2003, and the interest in the present application on October 16, 2003. Further, all inventors in both patent applications were under an obligation to assign their rights in these invention to Hewlett-Packard at the time the inventions were made. As such, the Applicants assert that 103(c) prohibits the use of the currently cited Vincent reference in a 103(a) rejection, and respectfully requests that the present rejection be withdrawn.

Though this combination of references falls under the purview of 103(c), the Applicant would like to briefly address the combination generally. If the Examiner were to use another reference that teaches silica covalently bonded to a fixer group or stabilizer group, the combination of such a reference with Held would still not provide the present invention. The present invention provides a dye covalently attached to inorganic porous particulates. The combination of Held with Vincent would not teach such a compound.

Held teaches a dye covalently bonded to a polymer. A combination with Vincent or a reference similar to Vincent, would not teach an inorganic porous particulate bonded to a dye because Held already has the dye bonded to a polymer. Held has already enhanced the dye stability and would have no reason to bond the dye to the inorganic porous particulate. Furthermore, it is noted that Held requires an external energy source to form the covalent bond between the ink and the media coating. See column 8, lines 20-25. However, the present claim set specifically states that the bond is formed “upon contact”; i.e. an external energy source is not required. Therefore, such a combination would still not provide the element of bonding on contact as required by the pending claim set. As such, the Applicant contends that the combination of Held in light of any reference similar to Vincent would not provide each and every element of the present invention.

In light of the above, the Applicant respectfully requests that the pending claim set be allowed.

In view of the foregoing, Applicants believe that claims 1-8 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone the assignee's counsel, W. Bradley Haymond at (541) 715-0159, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 29th day of November, 2006.

Respectfully submitted,



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